

REMARKS

The Office Action dated February 3, 2009, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 19, 32, 40, 51, 53, 57, 64 and 68-72 have been amended to more particularly point out and distinctly claim the subject matter of the invention. No new matter has been added and no new issues are raised. Claims 1-15, 17, 19, 21-30, 32-40 and 42-72 are presently pending.

The Office Action indicated that claims 1-15, 17, 19, 21-30, 53-59 and 69-72 have been allowed absent rejections under 35 U.S.C. §101 and 35 U.S.C. §112, second paragraph. Applicants wish to thank the Examiner for the allowance of these claims. Accordingly, in view of the following arguments, Applicants submit that all currently pending claims are in condition for allowance.

The Office Action objected to the specification for failing to provide antecedent basis for the term “computer readable medium”, which is included in the claim recitations of claims 69-72. This objection is respectfully traversed.

Applicants refer to §2173.05(e) of the MPEP, which discloses that,

“A CLAIM TERM WHICH HAS NO ANTECEDENT BASIS IN THE DISCLOSURE IS NOT NECESSARILY INDEFINITE”

“The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There

is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.”

Applicants submit that there is no lack of clarity or precision with respect to the claim recitations of any of claims 69-72. Furthermore, the specification does provide implicit support for a computer readable medium. For example, FIG. 2 illustrates two terminal devices 20 and 30, which include respective compressors/decompressors 22 and 32. In operation, a compressed item may include a compressed item code “00” “10” or “11”, which represents bits of data and may also include a “pos” field that provides position information. The compressor 22 and the decompressor 32, “are aware of the number of bits in the pos field 46.” The compressor and decompressor 32 operate at the bit level of the data communicated between the terminal devices 20 and 30, and, thus, must be able to support a computer readable medium if they are to process bits of information. The bit is the fundamental unit stored on and read from a computer readable medium. To say that bits are read and processed by two devices that do not include a computer readable medium is without merit. Accordingly, a computer readable medium is supported by the specification as filed and no explicit antecedent support is required under U.S. patent practice. Withdrawal of this objection is kindly requested.

Claims 1-15, 17, 19, 21-30, 53-59 and 69-72 were rejected under 35 U.S.C. §101 for allegedly being unpatentable. Specifically, it was alleged by the Office Action that

claims 23 and 69-72 are non-statutory types of invention. This rejection is respectfully traversed.

Initially, Applicants note that claim 23 recites “The method of claim 22, further comprising encoding said information regarding said difference within said compressed list.” The Office Action alleged that claim 23 recites a “computer readable medium.” Clearly, claim 23 includes no such claim recitation. Applicants note that if the Office Action intended to reject a different claim then the next Office Action cannot be made final since Applicants have not had an opportunity to identify the alleged rejection which is improper on its face. Withdrawal of the rejection of claim 23 is respectfully requested.

As for claims 69-72, Applicants have amended claims 69-72 to recite “A computer readable medium configured to store instructions that when executed control a processor to perform...” Applicants submit that claims 69-72 are directed to patentable subject matter under 35 U.S.C. §101.

As noted above, the specification does provide support for a computer readable medium. A computer readable medium may be regarded as a computer memory which a computing device is certain to include. Support for the definition of a computer readable medium is provided by *In re Lowry*, 32 F.3d 1579, 1583-1854, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994), which states: “When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” (see §2106.01 of the MPEP).

Therefore, a computer readable medium is statutory subject matter under 35 U.S.C. §101 and claims 69-72 are in compliance with 35 U.S.C. §101. Withdrawal of the rejections are kindly requested.

In addition to the above-noted rejection, the Office Action further rejected claims 1-15, 17, 19, 21-30 and 53-59 under 35 U.S.C. §101 for failing to be directed to statutory subject matter since these claims are allegedly not tied to a statutory class of invention. This rejection is respectfully traversed.

Applicants have amended claims 1, 19, 53, 57 and 69-72 to recite “a communication device” to tie a statutory apparatus to the operations recited in each of claims 1, 19, 53, 57 and 69-72. Support for this amendment is included in paragraph [0037] of the printed publication of the present application, which discloses the two devices illustrated in FIG. 2 are communicating over a network (i.e., a radio link). The operations performed in each of the rejected independent claims are thus tied to the communication device such that the communication device performs the comparing of the current item list to the reference list, determining a type of classification, and controlling the communication and compression of the packet header information (see claim 1 for example). Therefore, each of the pending claims are tied to a statutory class of invention. Withdrawal of the rejection is kindly requested.

Claims 53-68, 71 and 72 were rejected under 35 U.S.C. §112, second paragraph, for allegedly omitting an essential step of “transmitting a compressed packet header from one location to another location.” This rejection is respectfully traversed.

Claim 53 recites “receiving packet header information” and “decompressing the received header information.” Applicants submit that information that is received may well have also been transmitted prior to being received. Therefore, the Office Action’s allegation that receiving packet header information does not support packet header information that has been transmitted is without merit.

Furthermore, the standard applied to what is considered essential under U.S. patent practice requires that the actual subject matter omitted be designated as “essential.”

A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement, *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503. In the present case, there is no statement made by the Applicants that would support decompression must be performed after a signal has been transmitted. Therefore, to alleged that a claim recitation is essential when it is not regarded by the Applicant as being essential or critical would be contrary to U.S. patent practice. Withdrawal of the rejection is kindly requested.

For at least the reasons discussed above, Applicants respectfully submit that the claims recite patentable subject matter. It is therefore respectfully requested that all of claims 1-15, 17, 19, 21-30, 32-40 and 42-72 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, the applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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